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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,385	12/27/2000	Joyo Wijaya	WVANP013	6355

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IPVENTURE, INC.
5150 EL CAMINO REAL
SUITE A-22
LOS ALTOS, CA 94022

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,385

Applicant(s)

WIJAYA ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicants' "Amendment A" filed on June 22, 2004 has been considered with the following effect.

Claims 1-2, 4, 6, 10-13, 15, 17, 19-23, 25, 27-29, 31, 32 and 34 have been amended. New claim 36 has been added. Claim 33 has been canceled.

Election by Original Presentation

Newly submitted claim 36 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim has separate utility such as receiving a preference from the customer regarding substitution.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 36 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-32 and 34-35 remain pending in this application.

Response to Arguments

Applicants' arguments filed June 22, 2004 have been fully considered but they are not persuasive.

Applicants remark that "Nothing in Walker teaches or suggest that a customer order is received via a computer network.....Hence, Walker fails to teach or suggest receiving a customer order via computer network".

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The Examiner notes that Walker does disclose a customer order is received via a computer network. In col. 4, lines 42-50, Walker discloses a dispensing device which may be a vending machine, kiosk or any other mechanism that is controlled central processing unit (CPU). The central processing unit is operatively connected to standard computer components such as random access memory, read-only memory, input devices, output devices, and data storage device (col. 4, lines 51-55). A purchaser enters his or her selections for products through an external input device (col. 5, lines 8-10). The input devices and output devices may be one device such as a communication port that can both receive and transmit data (col. 5, lines 25-27). Furthermore, Walker discloses that the dispensing machine may be a networked device with the ability to store data either locally or at an alternate networked location (col. 13, lines 19-23). Such CPU connected to computer components such as input devices, output devices and data storage device, wherein the input and output devices are communication ports that can both receive and transmit data; and the machine may be a networked device are considered via computer network.

Applicants' remark that "Applicants' independent claims 1, 15, 23, and 29 make use of a customer order that includes more than one item, where each item can have a quantity greater than one. Regarding substitution,.....However, with respect to Applicants' independent claims 1, 15, 23 and 29, in determining whether an item has been oversold, more than one customer order is analyzed, while at least one item in each of those customer orders has not been delivered to the corresponding customer.

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Then, based on analysis, a substitute item is substituted for the over item....Hence, Walker also fails to teach or suggest the substitution recited in claims 1, 15, 23, and 29."

The Examiner draws Applicants' attention to the Office Action below.

Applicants' remark that Walker does not suggest or teach "predefined criteria includes instructions for minimizing a number of order substitutions to be performed for each customer order" and "the predetermined criteria includes instructions for selecting for substitution order line item which have a relatively highest order quantity".

The Examiner notes that Walker does disclose a predefined criteria which includes instructions for minimizing a number of order substitutions to be performed for each customer order. Walker discloses a CPU that is programmed to track and store which product is often selected after an initially selected product is identified as being unavailable. A product identifier corresponding to the most often alternatively-selected product may then be stored as a substitute product. (See col. 7, lines 53-58) For every product identifier, a substitute product identifier is listed (col. 8, lines 3-4). Such tracking and storing of which product is not available and the product identifier corresponding to the substitute product identifier are considered predefined criteria which includes instructions for minimizing a number of order substitutions to be performed for each customer order.

The Examiner notes that the claim recitation "the predetermined criteria includes instructions for selecting for substitution order line item which have a relatively highest order quantity" was amended to recite "the predefined criteria includes instructions for selecting for substitution an ordered item over another order item based on the

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corresponding quantity levels of the ordered item and the another order item". It is noted that the features upon which applicant relies (i.e., the predetermined criteria includes instructions for selecting for substitution order line item which have a relatively highest order quantity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants remark that Walker fails to teach or suggest any "sorting the identified order line items based upon the quantity value associated with each of the identified order line items; and sorting the identified order line items based upon a number of substitutions which has already been implemented in each customer order associated with the identified order line items".

The Examiner notes that the claim recitation "sorting the identified order line items based upon the quantity value associated with each of the identified order line items; and sorting the identified order line items based upon a number of substitutions which has already been implemented in each customer order associated with the identified order line items" was amended to recite "sorting the identified ordered items based upon the quantity value associated with each of the identified ordered items; and sorting the identified ordered items based upon a number of substitutions which has already been implemented in each customer order associated with the identified order items". It is noted that the features upon which applicant relies (i.e., sorting the identified order line items based upon the quantity value associated with each of the identified order line items; and sorting the identified order line items based upon a

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number of substitutions which has already been implemented in each customer order associated with the identified order line items) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants remark that "Brinkley's teaches away from Applicants' claimed invention. It is not clear how one can apply Brinkley's techniques if products in an order are changed". Furthermore, Applicants' remark that "there is no motivation to combine Brinkley with Walker.....There is no teaching, suggestion, or motivation to combine the reference".

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references may be found in Brinkley (col. 1, lines 15-16).

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Applicants' remark that Brinkley does not teach "the partially and fully substituting" of an ordered item.

The Examiner notes Brinkley does teach the partially and fully substituting. In col. 1, lines 30-32, Brinkley discloses the importance of the substitutability of goods. Furthermore, Brinkley discloses an accessing means which accesses inventory resources data corresponding to an inventory item to be evaluated, an analyzing means which analyzes the inventory resources data of the inventory item with the inventory resources data of the inventory portfolio; and a selecting means which selects an appropriate strategy for the inventory item based on the result of the analysis (col. 2, lines 41-52). Such importance of substitutability and the accessing, analyzing and the selecting means of an inventory item are considered the partially and fully substituting of an ordered item.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 15-19 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,520 to Walker.

Regarding claims 1, 15, and 23, Walker discloses a method, computer program product and a system for effecting substitution of at least one ordered item, comprising:

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- the receiving at least one customer order, the least customer order including at least one ordered item relating to an ordered quantity of a particular item of inventory (see at least col. 2, line 66 – col. 3, line 1; col. 7, lines 1-6; col. 11, lines 24-26; col. 11, lines 38-41);
- the analyzing a selected portion of the received customer orders to determine whether at least one item of inventor has been oversold (see at least col. 7, lines 24-36; col. 8, lines 13-49; col. 11, lines 24-47; col. 9 ,lines 39-47; col. 9, line 62- col. 10, line 4; col. 11, line 59-col. 12, line 8);
- the ordered items relating to an identified oversold item, wherein each order line item is associated with a respective customer order (see at least col. 7, lines 24-36; col. 8, lines 13-49; col. 11, lines 24-47; col. 9 ,lines 39-47; col. 9, line 62- col. 10, line 4; col. 11, line 59-col. 12, line 8); and
- the substituting, based upon predefined criteria, at least substitute item for the identified oversold item in at least one of the respective customer orders (see at least col. 7, line 50-col. 8, line 2).

However, Walker does not expressly disclose wherein the at least one customer order includes more than one ordered item, and wherein each ordered item in the at least one customer order can have a quantity larger then one and wherein at least one item each of the received customer orders has not been delivered to the corresponding customer. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The wherein the at least one customer order includes more than one ordered item, and wherein each ordered item in

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the at least one customer order can have a quantity larger than one and wherein at least one item each of the received customer orders has not been delivered to the corresponding customer would be performed regardless of the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in the terms of patentability, *see Gulack*, 703 f.2d, 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Circ.1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include more than one ordered item in the customer order, have a quantity larger than one in the customer order, and the at least one item of the customer order has not been deliver to the corresponding customer because such data does not functionally relate to the steps in the claims and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding claims 2-4, Walker discloses comparing the analyzed order data to inventory data to determine whether at least one item of inventory has been oversold (see at lest col. 7, lines 5-8; col. 7, lines 24-36; col. 8, lines 13-30; col. 8, lines 66- col. 9, line 6; col. 9, lines 39-47; col. 9, line 62 – col. 10, line 5; col. 11, lines 24-47); comparing occurs before fulfillment of the portion of received customer orders (see at least col. 11, line 24-col. 12, line 8); and substituting includes selecting, using the predefined criteria, desired ordered items corresponding to the identified oversold item (see at least col. 7, line 50 –col. 8, line 2; col. 11, line 59 –col. 12, line 8).

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Regarding claims 5-6, 9-11, 16-18, and 24-26, Walker discloses the predefined criteria includes instructions for minimizing a number of order substitutions to be performed for each customer order; the predefined criteria includes instructions for selecting for substitution an ordered item over another ordered item based on the corresponding quantity levels of the ordered item and the another ordered item; predefined criteria includes a sorted list of substitute products from which the substitute item is chosen; and predefined criteria includes ratio rules for substituting the substitute item for the first item. (See at least Figure 1; col. 7, line 50 –col. 8, line 2; col. 9, line 62–col. 10, line 4; col. 10, lines 14-16; col. 11, line 59 – col. 12, line 8; col. 12, line 62 – col. 13, line 3; col. 13, lines 8-10)

Regarding claims 7-8, Walker discloses the oversold item substitution occurs at a time of fulfillment of the portion of received customer orders and the fulfillment of an order is without intervention from a human operator (see at least col. 3, lines 1-7; col. 4, lines 39-50; col. 11, line 59–col. 12, line 8).

Regarding claims 12-13 and 27-28, Walker discloses sorting the identified order line items based upon the quantity value associated with each of the identified ordered items; and sorting the identified ordered items based upon a number of substitutions which has already been implemented in each customer order associated with the identified order line items. (See at least Figures 3-4; col. 6, lines 61-67; col. 7, lines 24-36; col. 7, lines 42–col. 8, line 7; col. 8, lines 13-30; col. 8, lines 45-49; col. 12, line 62 – col. 13, line 3).

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Regarding claim 19, Walker discloses predefined criteria to determine a first preferred substitution item for the identified oversold item; determining whether a sufficient quantity of the first preferred substitution item is available to be substituted for the identified oversold item. (See at least Figure 1; col. 7, line 50 –col. 8, line 2; col. 9, line 62- col. 10, line 4; col. 10, lines 14-16; col. 11, line 59 – col. 12, line 8; col. 12, line 62 – col. 13, line 3; col. 13, lines 8-10)

Regarding claim 29, Walker discloses a method for effecting substitution of at least one ordered item, comprising:

- the receiving at least one customer order, the least customer order including at least one ordered line item relating to an ordered quantity of a particular item of inventory (see at least col. 2, line 66 – col. 3, line 1; col. 7, lines 1-6; col. 11, lines 24-26; col. 11, lines 38-41);
- the analyzing at least a portion of the received customer orders to determine whether at least one item of inventory has been oversold (see at least col. 7, lines 24-36; col. 8, lines 13-49; col. 11, lines 24-47; col. 9, lines 39-47; col. 9, line 62- col. 10, line 4; col. 11, line 59-col. 12, line 8);
- identifying the ordered items relating to an identified oversold item, wherein each order line item is associated with a respective customer order (see at least col. 7, lines 24-36; col. 8, lines 13-49; col. 11, lines 24-47; col. 9, lines 39-47; col. 9, line 62- col. 10, line 4; col. 11, line 59-col. 12, line 8);

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- the substituting, based upon predefined criteria, at least one substitute item for the identified oversold item in at least one of the respective customer orders (see at least col. 7, line 50-col. 8, line 2);
- the substituting includes consulting the predefined criteria to determine a first preferred substitution item for the identified oversold item (see at least Figure 1; col. 7, line 50 –col. 8, line 2; col.9 ,line 62- col. 10, line 4; col. 10, lines 14-16; col. 11, line 59 – col. 12, line 8; col. 12, line 62 – col. 13, line3; col. 13, lines 8-10); and
- the substituting includes determining whether a sufficient quantity of the first preferred substitution item is available to be substituted for the identified oversold item (see at least Figure 1; col. 7, line 50 –col. 8, line 2; col.9 ,line 62- col. 10, line 4; col. 10, lines 14-16; col. 11, line 59 – col. 12, line 8; col. 12, line 62 – col. 13, line3; col. 13, lines 8-10).

However, Walker does not expressly disclose wherein the at least one customer order includes more than one ordered item, and wherein each ordered item in the at least one customer order can have a quantity larger than one and wherein at least one item each of the received customer orders has not been delivered to the corresponding customer. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The wherein the at least one customer order includes more than one ordered item, and wherein each ordered item in the at least one customer order can have a quantity larger than one and wherein at least one item each of the received customer orders has not been delivered to the

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corresponding customer would be performed regardless of the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in the terms of patentability, see *Gulack*, 703 f.2d, 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Circ.1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include more than one ordered item in the customer order, have a quantity larger than one in the customer order, and the at least one item of the customer order has not been deliver to the corresponding customer because such data does not functionally relate to the steps in the claims and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 14 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,520 to Walker in view of U.S. Patent No. 5,963,919 to Brinkley et al. Regarding claims 14 and 34, Walker substantially discloses the claimed invention, however, it does not disclose the aggregating a selected portion of the received customer orders to determine whether at least one item of inventory has been oversold. Walker discloses the monitoring (analyzing) of the selection of a first product by a purchaser (col. 3, lines 1-7). Brinkley, on the other hand, teaches the aggregating a selected portion of the received customer orders to determine whether at least one item of inventory has been oversold (see at least col. 4, lines 35-41; col. 4, lines 55-61; col. 5, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Walker, to include the

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aggregating, as taught by Brinkley, in order to fulfill customer's orders (Brinkley col. 1, lines 15-16).

Regarding claim 35 (which depend on claim 34), Walker discloses the substitution is performed automatically, without intervention by a human (see at least col.7, lines 50-58; col. 10, lines 14-16).

Regarding claims 21-22 and 31-32, Walker substantially discloses the claimed invention, however, it does not disclose the partially substituting and fully substituting. Walker discloses the determination of substitute products and/or services to over when a selected product and/or service is unavailable (col. 2, line 66- col. 3, line 1). Brinkley, on the other hand, teaches the partially and fully substituting (see at least col. 4, lines 35-41; col. 4, lines 62-col. 5, lines 9-15; col. 5, line 43 –col. 6, line 35). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Walker, to include the aggregating, as taught by Brinkley, in order to fulfill customer's orders (Brinkley col. 1, lines 15-16).

Claims 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,520 to Walker. Walker discloses substantially the claimed invention, however, it does not explicitly disclose the determination of a second preferred substitution item for the identified oversold item in response to a determination that there is an insufficient quantity of the first preferred substitution item available to be substituted for the identified oversold item. It would have been obvious to one of ordinary skill in the art to have provided the substitution already disclosed by Walker, such substitution would have been recognized by the skill artisan as providing

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numerous substitution in order to fulfill and satisfy the customer's order. Moreover, applicant has not persuasively demonstrated that the second substitution is critical or is anything more than substituting an item for the purpose taught by Walker. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second substitution for the purpose of fulfilling and satisfying the customer's order (Walker col. 2, lines 41-42).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,979,757 to Tracy et al. discloses a portable shopping system, wherein essential items are linked with alternative items.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
October 4, 2004

Michael Cuff 10/4/04
**MICHAEL CUFF
PRIMARY EXAMINER**